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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/637,210	08/08/2003	Ronald D. Blum	63049.000070	4088
7590 07/23/2004				
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Richmond, VA 23219-4074				
		EXAMINER		
		SCHWARTZ, JORDAN MARC		
		ART UNIT		PAPER NUMBER
		2873		
DATE MAILED: 07/23/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/637,210

Applicant(s)

BLUM ET AL.

Examiner

Jordan M. Schwartz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 May 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 7-16, 18, 19 and 21-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-5, 7-16, 18, 19, 21-32 and 35-39 is/are allowed.
- 6) ☒ Claim(s) 33 and 34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2/13/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Information Disclosure Statement

The information disclosure statement filed February 13, 2004 fails to comply with 37 CFR § 1.56(b), which states that information is material to patentability which is **NOT CUMULATIVE** to information...being made of record in the application. Applicant has cited 10 pages of references for consideration including the citing of an entire magazine (Eye Care Business) without setting forth the relevant pages within. The examiner believes that the thick stack of references for consideration is largely cumulative and, therefore, based upon the large number of references cited, the initialed references have been considered in a cumulative manner.

The information disclosure statement filed February 13, 2004 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each U.S. and foreign patent; each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. Specifically, the examiner could not locate the crossed out references and therefore they have not been considered. While it is possible that these references are within a parent application, applicant is claiming priority to at least nine previous applications. The examiner could not determine which if any of these applications these references are within and could not locate these references. It is suggested that applicant resubmit these references if applicant wants them to be considered.

Claim Rejections - 35 USC § 102

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim 33 is rejected under 35 U.S.C. 102(e) as being anticipated by Mann patent number 6,614,408.

Mann reads on this claim by disclosing the limitations therein including the following: an electro-active contact lens system that includes an electro-active element (column 15, line 65 to column 17, line 40 i.e. either or both the contact lens or camera system as electro-active); a view detector (column 17, lines 14-41). The view detector will inherently be stabilized at a predetermined orientation since it is located on the contact lens.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary

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skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over Large in view of Piosenka et al.

Large discloses the limitations therein including the following: an electro-active contact lens system (column 1, lines 6-12, column 2, lines 52-64); and an electro-active element attached to the contact lens (column 2, lines 52-64). Large discloses as is set forth above and further discloses the ophthalmic optical device electrically switching between different focal states through a power source (abstract) but does not disclose a view detector attached to the contact lens.

Piosenka et al teaches that in an ophthalmic lens system comprising an electro-active element attached to a power source for the purpose of switching between different focal states (abstract), that it is desirable to further include a view detector, specifically a range finder, attached to the ophthalmic lens system for the purpose of providing auto-focusing (column 5, line 44 to column 6, line 25). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have the electro-active lens system of Large as further comprising a view detector attached to the contact lens since Piosenka et al teaches that in an ophthalmic lens system comprising an electro-active element attached to a power source for the purpose of switching between different focal states, that it is desirable to further include a view detector, specifically a rangefinder, attached to the ophthalmic lens system for

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the purpose of providing autofocus. A view detector attached to the lens would inherently be stabilized at a predetermined orientation.

Claim 34 is rejected under 35 U.S.C. 103(a) as being unpatentable over Large in view of European application number 0 042 679.

Large reads on this claim by disclosing an electro-active contact lens (column 1, lines 6-12, column 2, lines 52-64) that includes an electro-active element encapsulated within a rigid material (column 2, line 59, column 6, line 65) but does not disclose the rigid material surrounded by a hydrophilic material. European'679 teaches that in a contact lens it is desirable to have a hard rigid material surrounded by a hydrophilic material for the purpose of providing an outer surface of the lens that provides increased comfort against the surface of the eye (page 4, line 1 to page 6 first paragraph). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have the contact lens of Large as having the rigid material surrounded by a hydrophilic material since European'679 teaches that in a contact lens it is desirable to have a hard rigid material surrounded by a hydrophilic material for the purpose of providing an outer surface of the lens that provides increased comfort against the surface of the eye.

Examiner's Comments

Aharoni et al publication number 2004/0117011 is being cited herein to show another reference that would have read on claim 33, however, such a rejection would have been repetitive.

Allowable Subject Matter

Claims 1-5, 7-16, 18-19, 21-32, and 35-39 are allowed.

The following is a statement of reasons for the indication of allowable subject matter: with respect to the allowable subject matter, none of the prior art either alone or in combination disclose or teach of the claimed combination of limitations to warrant a rejection under 35 USC 102 or 103. Specifically, with reference to independent claims 1, 16, and 35 none of the prior art either alone or in combination, disclose or teach of the claimed electro-active contact lens specifically including, as the distinguishing feature in combination with the other limitations, the claimed view detector stabilized between a palpebral fissure of a patient's eye. Specifically, with reference to independent claim 30, none of the prior art either alone or in combination, disclose or teach of the claimed electro-active contact lens specifically including, as the distinguishing feature in combination with the other limitations, the claimed electro-active element and view detector contained within a capsule. Specifically, with reference to independent claims 31-32, none of the prior art either alone or in combination, disclose or teach of the claimed electro-active contact lens specifically including, as the distinguishing feature in combination with the other limitations, the claimed view detector comprising a tilt switch, or a micro gyroscope or a micro accelerometer.

Response to Arguments

Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection set forth above.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jordan M. Schwartz whose telephone number is (571) 272-2337. The examiner can normally be reached on Monday to Friday (8:00-5:30), alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Georgia Y. Epps can be reached at (571) 272-2328. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'J. Schwartz', with a large, stylized loop at the end.

Jordan M. Schwartz
Primary Examiner
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July 17, 2004